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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,026	07/10/2001	Suhayya Abu-Hakima	8303/3	9283
20306 7590 02/07/2008 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606			EXAMINER HANNE, SARA M	
			ART UNIT 2179	PAPER NUMBER
			MAIL DATE 02/07/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/902,026

Applicant(s)

ABU-HAKIMA ET AL.

Examiner

Sara M. Hanne

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2008.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/4/08 has been entered.
2. This office action is responsive to the amendment received 1/4/08. Examiner notes pending New claims 17-26.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claims 17-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims fail to fall within one of the statutory classes of invention. None of the claimed elements of the system, (knowledge bases, concept recognizer component, concept learner component, prioritization analyzer component, viewer component) are defined as a physical part of a device, and each can be interpreted as merely software. Therefore the system cannot be interpreted as a machine or any of the other statutory classes of invention.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 17-19, 21-24, 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Millier et al., US Patent 5899995, hereinafter Millier.

As in Claims 17 and 22, Millier teaches an electronic document viewer system and method for personalized presentation to a user of a plurality of electronic documents input from a source over time and stored in storage means, said system and method comprising:

a knowledge base comprising a plurality of concepts, themes, sub-concepts and/or sub-themes (hierarchy stored in memory),

a user preferences knowledge base comprising preferences information personal to the user (voting or past usage Col. 3, line 18 et seq.),

a concept recognizer component configured for using the knowledge base for recognizing concepts, themes and sub-concepts, sub-themes associated with content of documents (ref. 230 Feature Recognizer) stored up to date in said storage means (Col. 3, lines 19-21 and Col. 9, lines 55-57),

a concept learner component configured for automatically learning dynamic information pertaining to the user based on prior actions of the user automatically

sensed by an environment sensor for input to the knowledge base (Column 3, lines 18 et seq.),

a prioritization analyzer component configured for dynamic ordering of the recognized concepts, themes and sub-concepts, sub-themes with the documents associated therewith (Fig. 8, 9 and corresponding text), according to priorities of the user determined from the preferences information (Col. 4, line 10 et seq.), wherein preferences information includes learned dynamic information (Col. 3, lines 19-34) and

a viewer component configured for presenting on an electronic display a first hierarchical level of multiple levels of prioritized concept identifiers interlinked according to a hierarchical structure based on said ordering (Fig. 2A), wherein each concept identifier represents the documents associated therewith and a concept, theme, sub-concept, sub-theme (Col. 5) and for presenting on the electronic display in turn one or more in turn (Col. 6, line 10) lower hierarchical levels of the hierarchical structure of prioritized concept identifiers upon selection thereof by the user from a concept identifier presented on the electronic display (Col. 5, line 55 et seq.).

wherein said association of said documents with said concept identifiers presented on the electronic display by the viewer component is updated on the basis of dynamic information pertaining to the user learned by the concept learner (Col. 3, lines 19-34).

As in Claims 18 and 23, Millier teaches an input document processing component configured for outputting a static document map corresponding to the input electronic documents (Col. 3, line 48 et seq.).

As in Claims 19 and 24, Millier teaches a highlighter component configured for identifying key content of said input document on the basis of said document map used by concept recognizer component (Col. 3, line 60 et seq.).

As in Claims 21 and 26, Millier teaches the viewer component configured for selectively presenting on the display, upon selection of one of the concept identifiers by the use, the next lower hierarchical level of concept identifiers (Col. 5, line 55 et seq.).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Millier et al., US Patent 5899995, hereinafter Millier, and further in view of Hyatt, US Patent 6678602.

In reference to Claims 20 and 25, Millier teaches identification of key content within an input document and creation of a static document map for creating a hierarchical configuration based on user's priorities and identified concepts (see rejections *supra*). While Millier teaches the viewer system and method for creating the hierarchy, recognizing concepts and themes, creating document maps and identifying key content, Millier fails to show displaying a predetermined amount of key content for a document corresponding to the particulars presented by the viewer component when a cursor operated by a user is positioned in the area of the particulars as recited in the claims. In the same field of the invention, Hyatt teaches a hierarchy configuration method similar to that of Millier. In addition, Hyatt further teaches displaying a predetermined amount of data for the node with which the cursor position corresponds ("provide a supplementary 'bubble' of information on the display when a mouse cursor is positioned on a node of interest", Column 13, lines 26-28). It would have been obvious to one of ordinary skill in the art, having the teachings of Millier and Hyatt before him at the time the invention was made, to modify the viewer system and method for creating the hierarchy as taught by Millier to include the proximity selection of nodes to display a given amount of key data of Hyatt, in order to obtain a preview for a node document that may be in consideration by the user. One would have been motivated to make such a combination because a method for previewing the information without opening the

document would have been obtained so as to determine whether or not the user is interested in the document, as taught by Hyatt.

***Response to Arguments***

Applicant's arguments filed 1/4/08 have been fully considered but they are not persuasive.

In response to the argument that "In Millier, there is no suggestion that the data in folders will be re-organized based on new knowledge that been learned." The examiner disagrees. Millier clearly teaches a learning system that is updated over time to adjust with the changing desktop automatically in Col. 3, lines 14-34.

The claim amendments fail to distinguish the invention from the previously stated prior art of record.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara M. Hanne whose telephone number is (571) 272-4135. The examiner can normally be reached on M-F 7:30am-4:00pm, off on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WEILUN LO can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sara M Hanne/  
Examiner, AU 2179